Appl. No. 09/718,604
Amdt. Dated 8/11/2004
Response to Office action dated 04/12/2004

REMARKS

Claims 1-37 are pending. No new matter has been added.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Claims 1-21, 25, and 28-37 have been amended, notwithstanding the belief that these claims were allowable. Except as specifically admitted below, no claim elements have been narrowed. Rather, cosmetic amendments have been made to the claims and to broaden them in view of the cited art. Claims 1-21, 25, and 28-37 have been amended solely for the purpose of expediting the patent application process, and the amendments were not necessary for patentability.

Any reference herein to "the invention" is intended to refer to the specific claim or claims being addressed herein. The claims of this Application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this Application, except for arguments specifically directed to the claim.

Claim Rejections - 35 USC § 112

The Examiner rejected claim 4 under 35 USC § 112, second paragraph as indefinite. The Examiner stated that "to thereby a first one" is unclear. Claims 4 and 32 have been amended. Claims 4 and 32 now read "[. . .] to thereby obtain a first one [. . .]." In current form, the rejection has been overcome.

Claim Rejections - 35 USC § 102

The Examiner rejected claims 1-6, 8, 12-16, 20-24, 28-32, 34 under 35 USC § 102(e) as anticipated by Nishio, et al. (USP 6,381,651). This rejection is respectfully traversed.

11/18

Nishio is a new home page information service (Nishio 6:38-39). Nishio uses a server computer to send a daily e-mail to a user with a list of web sites that suit the favorites of the user (Nishio, Abstract). Nishio's system requires personal information such as an e-mail address (Nishio, 4:61-67). Nishio's system requires the user to register demographic information (Nishio, 6:38-46 and 7:17-26). As new home pages are posted to the network, Nishio's server computer determines if the new home page is of the same genre as the user's favorites (demographic profile). If the new home pages are the same genre as the user's profile, then Nishio's server will include the new web site title in the daily e-mail to the user.

To anticipate a claim, the reference must teach each and every element of the claim. MPEP § 2131 provides:

> A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. [. . .]
> The identical invention must be shown in as complete detail as is contained in the ... claim.

Claims 1, 12, 20, and 28:

Claim 1 recites, among other features, "after the web browser requests the first web page, the client automatically obtaining a first one of the plural categories of human interest in which the first web page belongs." The Examiner contended that Nishio's "summary information" (Nishio, 5:17-21) teaches this feature. Nishio, at 8:59-62, shows that the summary information is the title from a new home page. Nishio's summary information (a title of a new home page) is not the same as "a first one of the plural categories of human interest." Therefore, the rejection is improper and should be withdrawn.

Claim 1 recites, among other features, "after the first one of the plural categories of human interest is obtained, the client automatically obtaining a first recommendation of a second web page which is in the first one of the plural categories of human interest." The Examiner contended that Nishio teaches this feature at 10:8-14. Nishio, at 10:8-14, shows that if the personal favorites

12/18

information coincides with the favorites information, then the summary information (title of a new home page) is supplied to the information delivering section (Nishio, 10:14-23). Nishio, at 10:44-11:12, shows that the information delivering section delivers the summary information (title of a new home page) in a bulk e-mail. The bulk e-mail is sent once a day (Nishio, 10:30-38). Nishio shows that a daily e-mail is sent to the user reflecting new web pages established on the internet. Nishio's e-mail is not related to the web browser requesting a first web page. Because the cited portion of Nishio does not teach the claimed feature, the rejection is improper and should be withdrawn.

To the extent that claims 12, 20, and 28 have features similar to claim 1, the arguments set forth for claim 1 are applicable to claims 12, 20, and 28. Therefore, claims 1, 12, 20, and 28 are in form for allowance. It is respectfully requested that the rejection be withdrawn.

Claims 2, 13, 21, and 29:

Claims 2, 13, 21, and 29 are dependent from claims 1, 12, 20, and 28, respectively. By virtue of their respective dependency on claims 1, 12, 20, and 28, claims 2, 13, 21, and 29 are patentable over Nishio.

Claims 3 and 31:

Claims 3 and 31 are dependent from claims 1 and 28, respectively. By virtue of their respective dependency on claims 1 and 28, claims 3 and 31 are patentable over Nishio.

Claims 4, 14-15, 22-23, 30 and 32:

Claims 4, 14-15, 22-23, and 30 and 32 are dependent from claims 1, 12, 20, and 28, respectively. By virtue of their respective dependency on claims 1, 12, 20, and 28, claims 4, 14-15, 22-23, and 30 and 32 are patentable over Nishio.

Appl. No. 09/718,604
Amdt. Dated 8/11/2004
Response to Office action dated 04/12/2004

Claims 5, 16, and 24:

Claims 5, 16, and 24 are dependent from claims 4, 15, and 20, respectively. By virtue of their respective dependency on claims 4, 15, and 20, claims 5, 16, and 24 are patentable over Nishio.

Claim 6:

Claim 6 is dependent on claim 5. By virtue of its dependence on claim 5, claim 6 is patentable over Nishio.

Claim 8 and 34:

Claims 8 and 34 are dependent from claims 1 and 28, respectively. By virtue of their respective dependency on claims 1 and 28, claims 8 and 34 are patentable over Nishio.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 7, 9-11, 17-19, 25-27, 33, 35-37 under 35 USC § 103 as obvious from Nishio, et al. (USP 6,381,651) in view of Schmid et al. (USP 6,438,578). This rejection is respectfully traversed.

Schmid is directed to sending a modified web page to a requesting user. Schmid's user requests a web page. The request is sent from a client to a server. Schmit's server determines if the request is a first request for the web page or a subsequent request for the web page. If the request is a first request, the web page is retrieved from an information provider and saved in a memory, and format and request instructions are sent from the server to the client. If the request is a second request for the web page, Schmid's server requests supplemental information (an advertisement), and then send the advertisement to the client along with the web page from the memory (Schmid 1:36-67).

14/18

Appl. No. 09/718,604
Amdt. Dated 8/11/2004
Response to Office action dated 04/12/2004

"To establish a *prima facie* case of obviousness, [. . .] the prior art reference (or references when combined) must teach or suggest all the claim limitations." *MPEP 706.02(j)*. Even if, in arguendo, the features of Nishio and Schmid were combinable, they would still fail to teach each and every feature of the claimed invention.

Claims 7, 17, 25, and 33:

Claims 7, 17, 25, and 33 are dependent from claims 1, 12, 20, and 28, respectively. As set forth above in the argument regarding the § 102 rejection of claims 1, 12, 20, and 28, Nishio fails to teach each and every element of claims 1, 12, 20, and 28. Moreover, the Examiner has not set forth how Schmid is both combinable with Nishio and teaches the features of claims 1, 12, 20, and 28 which Nishio fails to teach. Therefore, claims 7, 17, 25, and 33 are not obvious in view of Nishio in further view of Schmid. Thus, the rejection should be withdrawn and claims 7, 17, 25, and 33 should be allowed to issue.

Claim 7 recites, among other features, "providing the user with the option to access a next recommended web page." The Examiner contends that:

> In that art, Schmid, a related network data referral communication system, teaches 'network server determines whether a request is a second request', col. 6, lines 19-20 in order to provide relevant data. Schmid specifically teaches 'the network client to request supplemental information', col. 6, lines 42-43. Further, Schmid suggests identifying 'the supplemental information to the network client as having originated with the requested information source', col. 7, lines 14-16 which will result from implementing the referral and there are no limits on the number of supplemental requests possible. The motivation to incorporate multiple recommendations insures user demand is met. Thus it would have beeen obvious to one of ordinary skill in the art to incorporate multiple recommendations as taught in Schmid into the communication system described in Nishio because Nishio operates with multiple referrals and Schmid suggest that optimization can be obtained by providing multiple or supplemental referrals.

Schmid's "second request", at 6:19-20, is related to the user's request for a specific web page. If Schmid's network server determines the request is a second request for a specific web page, then

15/18

Appl. No. 09/718,604
Amdt. Dated 8/11/2004
Response to Office action dated 04/12/2004

Schmid's network client requests supplemental information. Schmid's "supplemental information" includes "advertisements of businesses that offer goods or services" (Schmid, 6:48-49). Schmid's network server then sends the specific web page and the advertisement (supplemental information) to the user. The cited sections of Schmid are not related to the claimed feature and do not teach or suggest "providing the user with the option to access a next recommended web page." Therefore, the rejection is improper and should be withdrawn.

To the extent that claims 17, 25, and 33 have features similar to claim 7, the arguments set forth for claim 7 are applicable to claims 17, 25, and 33. Therefore, claims 17, 25, and 33 should be allowed to issue.

Claims 9, 18, 26, and 35:

Claims 9, 18, 26, and 35 are dependent from claims 1, 12, 20, and 28, respectively. As set forth above in the argument regarding the § 102 rejection of claims 1, 12, 20, and 28, Nishio fails to teach each and every element of claims 1, 12, 20, and 28. Moreover, the Examiner has not set forth how Schmid is both combinable with Nishio and teaches the features of claims 1, 12, 20, and 28 which Nishio fails to teach. Therefore, claims 9, 18, 26, and 35 are not obvious in view of Nishio in further view of Schmid. Thus, the rejection should be withdrawn and claims 9, 18, 26, and 35 should be allowed to issue.

Claim 9 recites, among other features, "the client automatically obtaining a second recommendation of a third web page which is in the first one of the plural categories of human interest." The Examiner contended that Schmid's "supplemental page" suggests this feature at 6:48-56. Schmid's supplemental page is an advertisement. It is not a second recommendation of a third web page which is in the first one of the plural categories of human interest. Since the cited portion of Schmid does not teach or suggest the claimed feature, the rejection is improper and should be withdrawn.

16/18

Claim 9 recites, among other features, "after the step of the web browser outputting the second web page to the output device, the user providing input to the client indicative of the user's desire to activate the second recommendation, and in response the client causing the web browser to request the third web page." The Examiner contended that Schmid teaches this feature at 5:9-11. Schmid, at 5:9-11, is related to the communication monitoring means determining whether a user's request of a web site is the first request for the web site or the second request for the web site. The cited portion of Schmid is unrelated to the claimed feature. Since the cited portion of Schmid does not teach or suggest the claimed feature, the rejection is improper and should be withdrawn.

To the extent that claims 18, 26, and 35 have features similar to claim 9, the arguments set forth for claim 9 are applicable to claims 18, 26, and 35. Therefore, claims 18, 26, and 35 should be allowed to issue.

Claims 10-11, 19, 27, and 36-37:

Claims 10-11, 19, 27, and 36-37 are dependent from claims 1, 12, 20, and 28, respectively. As set forth above in the argument regarding the § 102 rejection of claims 1, 12, 20, and 28, Nishio fails to teach each and every element of claims 1, 12, 20, and 28. Moreover, the Examiner has not set forth how Schmid is both combinable with Nishio and teaches the features of claims 1, 12, 20, and 28 which Nishio fails to teach. Therefore, claims 10-11, 19, 27, and 36-37 are not obvious in view of Nishio in further view of Schmid. Thus, the rejection should be withdrawn and claims 10-11, 19, 27, and 36-37 should be allowed to issue.

Conclusion

It is submitted, however, that the independent and dependant claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.
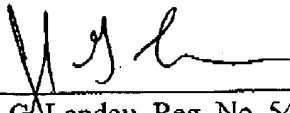
17/18

Appl. No. 09/718,604
Amdt. Dated 8/11/2004
Response to Office action dated 04/12/2004

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Date: August 11, 2004

Joel G. Landau, Reg. No. 54,732

SoCal IP Law Group
310 N. Westlake Blvd., Suite 120
Westlake Village, CA 91362
Telephone: 805/230-1350
Facsimile: 805/230-1355
email: info@socalip.com

18/18